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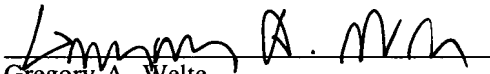
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THE UNITED STATES PATENT AND TRADEMARK OFFICE

Assignee's Docket No.: 9084.00)
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Group Art Unit: 3693)
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Serial No.: 09/966,023)
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Examiner: Kirsten Sachwitz Apple)
)
Filing Date: September 28, 2001)
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Title: Self-Service Terminal)
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CERTIFICATE OF MAILING

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APPEAL BRIEF

A Summary of Argument Begins on Page 8

The fee for this Brief may be billed to Deposit Account 14 - 0225. NCR Corporation.

1. REAL PARTY IN INTEREST

NCR Corporation.

2. RELATED APPEALS AND INTERFERENCES

None.

3. STATUS OF CLAIMS

Claims 1, 2, 9 - 14, and 18 - 26 are pending, rejected, and appealed.

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Claims 3 - 8 and 15 - 17 are cancelled.

The Examiner has withdrawn some claims, but has not clearly identified them. The Final Office Action, page 2, refers to claims "8 - 35." However, that is a clear typographical error: there is no claim 35.

The withdrawn claims appear to be 24 - 26, because

- 1) the Final Office Action, page 2, asserts that those claims represent a separate invention, and
- 2) all pending claims except claims 24 - 26 are expressly rejected.

4. STATUS OF AMENDMENTS

No Amendments-After-Final have been submitted.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Summary

A simple example will illustrate basic principles of the invention.

Students attend a school, and often bring money with them for lunch, supplies, and other items. However, the students can lose the money, or it can be stolen. (Specification, page 1, lines 9 - 17.)

Under one form of the invention, the school maintains an ATM,

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Automated Teller Machine, to which the students are granted access.
(Specification, page 5, lines 5 - 7; ATM 14a, Figure 1.)

Each student is assigned a financial account. To pay for a meal, for example, the student uses an ATM card. The ATM arranges payment to the school for the meal. The student can purchase school supplies in a similar manner. (Specification, page 6, line 21 et seq.; page 8, line 3 et seq.)

The ATM also functions as an ordinary ATM, which dispenses cash, etc. (Specification, page 10, line 18 et seq.; page 6, line 16 et seq.)

Rules are imposed on the students' usage of the ATM, such as rules which limit (1) the times-of-day when students can use the ATM, (2) the amounts of money available to the students, (3) the types of purchases which can be made, and so on. (Specification, page 7, lines 12 - 21.)

Mapping of Claim Elements to Specification and Figures

Parenthetical phrases, in **bold typeface**, are inserted into the following independent claims, to identify matter in the Specification and Figures which supports the claim language adjacent said **bold, parenthetical typeface**.

1. A method of providing financial transactions via a self-service terminal (**ATM 14a, Figure 1; page 8, lines 3 - 7**)

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associated with an organization (block 18, Figure 1; page 5, lines 5, 6) having individuals under its supervision, the method comprising the steps of:

maintaining a financial account for the organization (page 2, lines 6 - 9; page 3, lines 12, 13);

maintaining a financial account for an individual under the supervision of the organization (account 90, Figure 1; page 7, lines 9 - 11);

allowing a sponsor and/or the organization to establish rules governing use of funds within the financial account by the individual (rules 92, Figure 1; page 3, lines 6 - 9; page 7, lines 4 - 7); and

when a transaction is requested by the individual at a self-service terminal located in premises used by the organization, examining the rules and fulfilling the transaction if the transaction is consistent with the established rules for that individual (page 8, line 25 - page 9, line 12).

9. A financial transaction system comprising:

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- a) a self-service terminal, SST, in communication with a transaction host, wherein the terminal is associated with an organization having individuals under its supervision (ATM 14a, Figure 1; host 12, Figure 1; page 8, lines 25 - 27; page 5, lines 8 - 10; page 2, lines 1 - 5);
- b) means for maintaining a financial account for an individual under the supervision of the organization (host 12, Figure 1, and other components in Figure; page 3, lines 13 - 15);
- c) means for allowing a sponsor and/or the organization to establish rules governing use of the financial account by the individual, said rules being accessible to the SST or the host (rules 92, Figure 1; page 3, lines 6 - 9; page 7, lines 4 - 7; page 8, line 25 - page 9, line 12); and
- d) means for fulfilling a transaction requested by the individual at the terminal if the transaction is consistent with the established rules for that individual (host 12, Figure 1, and other components in Figure; page 8, line 25 - page 9, line 12).

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12. A financial transaction system comprising:
- a) an automated teller machine (ATM) (ATM 14a, Figure 1; page 5, lines 1 - 5) in communication with a transaction host (Host 12, Figure 1; page 1, lines 1 - 5), wherein the ATM is associated with an organization having individuals under its supervision (page 3, lines 10 - 12);
 - b) means for maintaining a financial account for an individual under the supervision of the organization (page 3, lines 14, 15; page 7, lines 9 - 11; account 90, Figure 1);
 - c) means for allowing a sponsor and/or the organization to establish rules governing use of the financial account by the individual, said rules being accessible to the ATM or the host (rules 92, Figure 1; page 3, lines 6 - 9; page 7, lines 4 - 7; page 8, line 25 - page 9, line 12); and
 - d) means for fulfilling a transaction requested by the individual at the ATM if the transaction is consistent with the established rules for that individual (host 12, Figure 1,

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and other components in Figure; page 8, line
25 - page 9, line 12).

24. A method of providing account-access to individuals in
an organization, comprising:

- a) setting up an account for each individual (page 7,
lines 9 - 11);
- b) establishing rules on the usage of funds within each
account, wherein different accounts have different sets
of rules (page 7, lines 12 - 21; page 2, lines 10 - 13;
page 3, lines 15 - 18);
- c) maintaining the accounts and the rules in a computer
system (account 90, Figure 1; page 7, lines 9 - 21);
- d) allowing one or more Automated Teller Machines, ATMs,
or their hosts to obtain access to the accounts and rules
(page 2, lines 1 - 5; page 8, line 25 - page 9, line 12);
- e) when an individual requests a transaction at one of
the ATMs, ascertaining whether the transaction complies
with the rules for the individual's account and, if so,
executing the transaction and, if not, displaying a
rejection message (page 9, lines 1 - 9; page 3, lines 10
- 18).

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6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The rejection of claims 1, 2, 9 - 14, and 18 - 23 under 35 USC § 102, based on Slater.

The "constructive election" imposed on Appellant, which withdraws added claims 24 - 26 from consideration.

7. ARGUMENT

SUMMARY OF MAJOR POINTS IN ARGUMENT

OVERVIEW OF SUMMARY

The independent claims recite

- establishing "rules" and
- later examining **those same rules** when a "transaction" is requested, to ascertain whether the transaction complies with the "rules" established.

To show the "rules" which are "established," the PTO relies on "government regulations" in Slater (column 3, line 11).

To show the examination of the "rules," the PTO relies on an electronic funds transfer process in Slater (column 4, lines 11 - 39, especially lines 34 and 35.)

But the electronic funds transfer process in Slater does not examine the "government regulations." If "rules" are present in that process, those are **different** rules than the "government regulations."

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The claims state that the "rules" **which were established are the rules which are examined** in connection with the transaction.

Slater does not show this. Slater examines **different** rules (if he performs examination at all).

This fact is sufficient to preclude all rejections.

DETAILED SUMMARY

Slater Reference

All claims were rejected on grounds of anticipation, based on Slater.

In Slater, employees are paid their salaries via "stored value cards," which are, in essence, prepaid credit cards. (Column 2, lines 20 - 26.) The employees can obtain their salaries by, for example, using the cards at an ATM, Automated Teller Machine, to withdraw cash. (Column 2, lines 32 - 35.)

The PTO relies on two **different** elements in Slater, to show **a single** claim recitation.

First Element

Slater states that, in his system, an "implementation specialist" assures that "government regulations" are followed. (Column 3, lines 8 - 12.) Slater does not appear to elaborate on the meaning of this, but it would appear that he means that appropriate tax deductions, such as withholding tax, are taken from

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the employees' salaries.

The PTO uses these "government regulations" are used to show the claimed "rules" which are "established." (But not the "rules" which are applied, or examined, when a transaction occurs. The claim states that **the same** "rules" are used in both situations.)

Second Element

Slater states that, to make a deposit to a stored value card, a pre-existing electronic network, used by banks, can be used. (Column 4, lines 12 - 30, especially lines 26 - 30.) The depositor creates a data packet containing the necessary information, such as the card's account number and the amount of the deposit. (Column 4, lines 19 - 21 and 28 - 32.)

However, because that pre-existing network is designed to handle deposits into checking accounts (ie, "demand deposit accounts"), and not deposits into stored-value cards, the network re-routes the data packet to the appropriate system, which handles deposits to the cards in question. (Column 4, lines 30 - 44.)

Slater calls this re-routing "rejection." (Column 4, line 33: "The transmission is rejected.")

The PTO asserts that this re-routing is an **application** of the claimed "rules," during the claimed "transaction."

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Comments on Slater

The claims recite a **single** set of rules, which are (1) established and then (2) applied, as by examining them when a transaction occurs, to determine whether to allow the transaction.

The PTO is treating the "government regulations" of Slater as the rules which are created.

Then the PTO treats **different** rules, used in the electronic transfer of funds, as the rules which are **applied** during a claimed "transaction."

That is faulty claim interpretation.

The same set of rules must be found in both (1) the creation of the rules and (2) the application of the rules to the transaction.

Stated more simply:

-- Claim 1 states that "rules" are
"established."

-- Claim 1 then states that "**THE** rules" are
"examined" during a "transaction."

Thus, the "rules" which are "examined" must be **the same** "rules" which were previously "established." In Slater, that is not so.

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Further Application of Slater to Claims

Content of Claim 1

Claim 1 recites an "individual" who is "under" "supervision" of an "organization." For example, a student (the "individual") may be under "supervision" of a school (the "organization").

Claim 1 also recites creation of "rules governing use of funds within the financial account by the individual." The "organization" may create the "rules." Thus, the student's use of the funds is restricted by the "rules."

Claim 1 further states that a "self service terminal" (SST) exists on the "premises" of the "organization." The SST may be a cash machine, usable by the student, and present at the school.

Claim 1 further states that when the "individual" "requests" a "transaction" at the SST, the "rules" are "examined," and the "transaction" is "fulfilled" if it is "consistent" with the "rules." For example, if the requested transaction relates to a payment for lunch, the rules may allow the transaction between 11:00 am and 1:00 pm, but not at other times.

Application of Slater

As explained above, the PTO asserts that the "government regulations" of Slater show the claimed "rules" which are "established." This assertion is necessarily false, for several reasons.

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REASON 1

Claim 1 states that a "sponsor and/or the organization" establish the rules. It may be true that "government regulations" are "established," but that is done by a "government."

The PTO has not shown that any "government" in Slater corresponds to the claimed "sponsor and/or organization" which establishes the claimed "rules."

The claimed "sponsor and/or organization" which establishes the rules has not been shown in Slater.

REASON 2

Claim 1 states that the "rules [govern] use of funds within the financial account by the individual."

The "government regulations" of Slater have not been shown to do this.

Further, the "government regulations" in Slater have not even been identified. Some "government regulations" require that banks clear checks within a certain time period. If Slater is referring to those regulations, then they clearly have no relevance to the claims.

As a minimum, the type of government regulations in Slater must be identified.

Further, "government regulations" do not apply to specific

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individuals, but to behavior generally. That is, specific behavior is regulated, and anybody who performs the behavior violates the regulation.

But government regulations do not state, for example, "Party A, who has funds in account A, cannot spend the funds on Sundays." That would probably be illegal, as a violation of Equal Protection, for example.

Thus, the claim states that the "rules" apply to the behavior of a specific individual. "Government regulations," in general, do not single out individuals and apply to them. And even if they do, that type of government regulation has not been shown in Slater.

REASON 3

Claim 1 states that the rules, after being "established," are then "examined" when a "transaction" is "requested." At that time, if the "transaction" is "consistent" with the "rules," then the "transaction" is "fulfilled."

Further, the "transaction" occurs at an SST "located on the premises of the organization."

None of this occurs with respect to the "government regulations" of Slater.

-- The PTO has not shown that the "government regulations" are "examined" during a

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"transaction" "requested" by "the individual."

-- "The individual" (who "requests" the "transaction") must be "under" "supervision" of the "government," for Slater to show the claim. The PTO has not shown that.

-- The "transaction" must occur at an SST "on premises" of the "government." The PTO has not shown that.

REASON 4

As explained above, the PTO relies on a **completely different set of rules** in Slater to show the recitations discussed in Reason 3, above. That, by itself, is sufficient to defeat the rejection.

That is, in simple terms, claim 1 first recites establishing "rules."

Claim 1 then recites "examining" **"THE RULES"** in connection with the "transaction."

Those must be **the same rules** which were "established."

But the PTO relies on a **completely different** set of rules in Slater, to show the "rules" which are "examined." Those different rules cause the "rejection" of Slater's column 4, lines 34 and 35.

The PTO has not shown that the claimed "rules" which are "established" are the same "rules" which are "examined."

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Conclusion

The processes of "establishing" the claimed "rules" and then "examining" those "rules" have not been shown in Slater.

The claims state that the "rules" "[govern] use of funds within the financial account by the individual." The PTO has not shown that the "government regulations" of Slater do this.

The claimed "examining" is done in connection with a "transaction" at an SST "on the premises" of the "organization." If Slater shows the claims, then an SST must be on the "premises" of the "government." That has not been shown.

For these and other reasons, Slater does not show claim 1.

This Summary applies to all independent claims.

Re: Constructive Election and Withdrawal of Claims 24 - 26

Appellant submitted a previous Amendment. It was entered.

The Final Office Action has unilaterally, without Appellant's prior knowledge or consent, withdrawn claims 24 - 26 of that Amendment.

However, several problems exist in this unilateral action.

Problem 1

The basis for the withdrawal is that claims 24 - 26 cover an invention which is "independent OR distinct." That is the wrong standard.

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The standard is whether the invention is "independent **AND** distinct."

Thus, the Office Action is applying the wrong rule.

Problem 2

Independent claim 24 (which was withdrawn) is not a separate invention, as defined under restriction practice. It is a method claim of the same general type as the other independent claims. Thus, in fact, no separate invention is present in added claim 24.

Problem 3

The Final Office Action (page 2) cites 37 CFR § 1.142(b) and MPEP § 821.03 in support of its action. However, as explained herein, neither of those sections allow the Examiner to unilaterally withdraw claims, to thereby choose which claims are to be prosecuted.

Problem 4

The Final Office Action (page 2) asserts that a "constructive" election has been made by Appellant.

However, a "constructive" election is one which is not made expressly, but which is inferred, based on the conduct of Appellant.

In this case, Appellant undertook no conduct whatsoever, and

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no such conduct has been identified, which indicated that Appellant wishes to withdraw claims 24 - 26.

Further, such an inference is **directly contrary to undisputed facts**. For example, the undersigned attorney drafted the claims in question, submitted them, and made brief arguments as to why they are patentable (Amendment mailed on November 7, 2006, page 14.).

In view of these actions by Appellant, it is contrary to both the facts, and to common sense, to draw the inference that Appellant undertook those actions with the intent that those claims be immediately withdrawn.

Such an inference would mean that the undersigned attorney deliberately undertook a course of action which was a complete waste of time, and was known to be a waste of time during the undertaking.

Such an inference defies common sense.

And the undersigned attorney expressly states that, at no time in the past, did he have any intent to withdraw claims 24 - 26.

Problem 5

The proper procedure is to issue a restriction requirement. That has not been done.

END OF SUMMARY

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ARGUMENT

RESPONSE TO ANTICIPATION REJECTION OF CLAIMS 1, 2, 9 - 14 AND 18 - 23

Claim 1

Claim 1 recites:

1. A method of providing financial transactions via a self-service terminal associated with an organization having individuals under its supervision, the method comprising the steps of:

maintaining a financial account for the organization;

maintaining a financial account for an individual under the supervision of the organization;

allowing a sponsor and/or the organization to establish rules governing use of funds within the financial account by the individual; and

when a transaction is requested by the individual at a self-service terminal located in premises used by the organization, examining the rules and fulfilling the transaction if the transaction is consistent with the established rules for that individual.

Three elements of the claim are relevant here.

-- ONE. Rules are established for use of funds within the account.

-- TWO. The rules are later examined.

-- THREE. A requested transaction is fulfilled if it is consistent with the rules.

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For example, as Applicant's Specification explains on page 9 and elsewhere, if a student requests a meal ticket at times when meals are being served, the ticket is issued.

-- The "rule" would be that meal tickets are issued only at certain times.

-- When the request for the meal ticket is made, the rules are examined.

-- If the request is made at the correct time, the meal ticket is issued.

These three elements are missing from Slater.

Element 1

POINT 1

The Final Office Action asserts that

1) item 16 in Slater's Figure 1
and

2) Slater's column 3, lines 8 - 15,

show the claimed "rules."

However, that passage in Slater states that an "implementation specialist" assists in setting up (ie, "implementing") Slater's system. In Slater's system, "value-added cards" (like credit cards) are issued to people instead of checks or cash. (See column 2, lines 10 - 18.)

Slater's column 3, lines 8 - 15, does state that the

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"implementation specialist" assures that government regulations are followed by Slater's system. But that does not correspond to the claimed "rules."

The claimed rules apply to usage of funds within the specific account of the individual. The claim states that the

. . . rules [govern] use of funds within the financial account by the individual.

The claim further recites

. . . examining the rules and fulfilling the transaction if the transaction is consistent with the established rules for that individual.

The claimed types of rules have not been shown in Slater. Nor have the claimed examination and fulfillment of a transaction been shown in Slater.

The PTO has only asserted that Slater's "implementation specialist" assures that government regulations are properly followed. That is insufficient to show the two-fold claim language cited above.

This latter point bears repeating.

The PTO relies on a **single** citation in Slater, namely:

Implementation . . . may include ensuring that applicable government regulations are properly

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followed . . .

(Column 3, lines 9 - 11.)

The "application" mentioned is apparently an "application computer program" which issues a "stored value card" to employees on payday. (Column 2, lines 19 - 39.) The undersigned attorney surmises that the "governmental regulations" are the tax laws which require withholding of taxes, etc.

Slater's assuring that a computer program deducts taxes from an employee's salary does not correspond to the claimed "rules," their establishment, and their examination.

POINT 2

The "rules" upon which the PTO relies in Slater are "government regulations." (Column 3, line 11.)

Those do not correspond to the claimed "rules." The claimed "rules" are not made by a government.

Further, the claimed "rules" perform a specific function. They "[govern] use of funds within the financial account by the individual."

The "government regulations" of Slater do not do that, or at least have not been shown to do that.

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CONCLUSION

The "government regulations" of Slater do not correspond to the claimed "rules." This element (the "rules") is missing from Slater.

MPEP § 2131 states:

A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Elements 2 and 3

The Office Action cites Slater's column 4, lines 33 - 36, as showing the last paragraph of the claim (examining the rules and fulfilling the transaction if proper).

However, that passage is part of a discussion (column 4, lines 11 - 39) on how Slater deposits funds electronically into the stored value cards. The discussion states that, to make a deposit to a stored value card, a depositor can use a pre-existing system, namely, the ACH, Automated Clearing House.

However, the ACH will re-route the stored-value-deposit to another system, because the stored-value-deposit does not relate to a "demand deposit account number." (Column 4, lines 30 - 35. A "demand deposit" is an account, such as a checking account, in which the funds are available on "demand.")

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The Final Office Action cites the re-routing (which Slater calls "rejection") as showing the claimed examination of the claimed rules, and fulfillment of the transaction.

However, several problems exist in this assertion.

PROBLEM 1

The claim states that the examination/fulfillment is done in connection with a "transaction . . . at a self-service terminal."

No such "transaction" has been shown in Slater, in connection with the re-routing ("rejection") of the deposit to a stored value card.

PROBLEM 2

Under the claim, the "transaction" is "requested by **THE** individual." "**THE** individual" has a "financial account."

The "transaction" cited in Slater, column 4, lines 33 - 36, is not "requested" by such an individual. The "transaction" in Slater is the deposit to the stored-value card, and that deposit is made by an employer.

Nor is the "transaction" (the deposit to the stored-value card) in Slater requested "at a self-service terminal," as claimed, as Problem 1, above, explained.

PROBLEM 3

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The cited passage in Slater is **opposite** to what is claimed.

The claim refers to **spending money in an account**. The spending is allowed if the rules are followed.

Slater's "rejection" occurs in connection with a **DEPOSIT to a stored value card**.

In the claim, money is **depleted** from an account. In Slater, money is **added to** an account.

PROBLEM 4

This is a continuation of Problem 3.

The claim refers to rules governing the **spending** of money in the claimed accounts, such as accounts of students.

It makes no sense that similar rules could exist in the cited passage of Slater, where a deposit is re-routed.

Therefore, any rules in Slater are of a **completely different type** and for a **completely different purpose**. They do not correspond to the claimed rules.

PROBLEM 5

Under the claim, the "rules" "[govern] use of funds within the financial account by the individual."

The "rejection" in Slater is unrelated to any such "rules." Nothing in the "rejection" affects how a person can use the stored value card in Slater.

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PROBLEM 6

Under the claim, **EITHER** a "sponsor" or the claimed "organization" can "establish" the "rules."

That is, under the claim, the claimed "organization" has power to "establish" the "rules."

No "organization," having the characteristics claimed, establishes any of the "rules" involved in the "rejection" in Slater. For example, under the claim, the following characteristics are present:

- 1) the "organization" has "individuals under its supervision;"
- 2) those "individuals" have "financial accounts" which they can use;
- 3) the "rules" "govern" use of "funds" in those "accounts" (which "accounts" belong to the "individuals"); and
- 4) the "organization" can make the "rules."

These four recitations are simply not found in the "rejection" of Slater.

The PTO purports to find **some** of those recitations in Slater, such as "rules" and "accounts." But that is insufficient.

Claims are read as-a-whole. Every claim recitation must be shown in Slater.

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Contradiction in Office Action

The Final Office Action is applying a **single** claim term (the "rules") to **two different entities in Slater**.

On the one hand, the Final Office Action finds the claimed "rules" which are established in Slater's "government regulations" of column 3, line 11. (Final Office Action, page 3, third paragraph.)

On the other hand, the Final Office Action finds the claimed **application** of the claimed "rules" in the "rules" which are supposedly present in the electronic processing of deposits to stored value cards, as exemplified by the "rejection" occurring in Slater's column 4, lines 33 - 36. (Final Office Action, page 3, fourth paragraph and pages 5 and 6.)

The Final Office Action is applying the claimed "rules" to **two completely different sets of "rules" in Slater**.

That is not allowed.

In addition, the **two DIFFERENT sets of rules, even if present in Slater**, are mutually contradictory, as to their origin.

-- One set of rules is the "government regulations" of column 3, line 11.

-- The other set is the "rules" used in electronic funds transfers.

But the government does not establish the latter rules, or at

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least that has not been shown.

Response to Final Office Action

POINT 1

The Final Office Action, pages 5 and 6, asserts that "rules" are inherently present in Slater's system of stored value cards.

In response, Appellant points out that the claims do not recite merely "rules." Claim 1 recites, for example,

1) specific rules exist which allow transactions if the rules are followed,

and

2) an "organization" is allowed to establish the "rules,"

and

4) a "self-service terminal" (SST) is associated with the "organization,"

and

5) the transaction in question is "requested" "at" the SST, where the "rules" are applied.

The mere presence of "rules" in Slater is not dispositive.

POINT 2

The Final Office Action relies on the Doctrine of Inherency to show that the claimed "rules" are found in Slater.

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MPEP § 2112 states:

EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE
TENDING TO SHOW INHERENCY.

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

No such "basis in fact" or "technical reasoning" has been given.

Conclusion as to Claim 1

Appellant therefore submits that claim 1 is not found in Slater, for the several reasons given above. Of those, perhaps the simplest reason is the fact that claim 1 recites

- 1) establishing "rules" and then
- 2) examining **those same rules** in a later transaction.

The Final Office Action tacitly admits that these recitations are not found in Slater, because the Office Action relies on **two different sets of rules** in Slater to show (1) and (2) above.

Slater does not examine the "rules" which were supposedly established, as claimed.

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Extension to Other Claims

The discussion of claim 1 applies to all the independent claims.

Claim 2

Claim 2 recites:

2. A method according to claim 1, further comprising the step of offering the individual products and/or services provided by the organization.

Point 1

The Final Office Action cites Slater, column 2, line 35 as showing the claim.

However, that passage merely refers to employee's withdrawing their salaries, in whole or in part, from Point of Sale (POS) terminals.

That passage does not state that the employees purchase anything. The claim states that products/services are offered for sale. No purchases by the employees in Slater have been shown.

Point 2

Parent claim 1 states that the "organization" "maintains a financial account for an individual."

Parent claim 1 also states that the "individual" is "under

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the supervision" of the "organization."

Dependent claim 2 states that the "organization" offers "products and/or services."

The PTO has not shown that the owner of the POS's in Slater correspond to the claimed "organization," as is required by the claim language.

That is, the claimed "organization" must operate the POS in Slater, because the claim states that the self service terminal is located at the "organization."

Point 3

It has not been shown that the POS in Slater performs the recitations of the last paragraph of parent claim 1.

Claims 10 and 13

Point 1

Claim 10 states that the "terminal is located in premises used by the organization."

Under parent claim 9, the "terminal" is that at which the "individual" "requests" a "transaction."

Under parent claim 9, for the "transaction" to be "fulfilled," the "rules" must be followed.

Thus, the "transaction" occurs at a "terminal" located at the "organization," and the "rules" must be followed in that

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"transaction."

To show claim 10, the PTO relies on employees in Slater who withdraw their salaries, in whole or in part, from Point of Sale (POS) terminals.

But the PTO has not shown that any "rules," as claimed, are involved in those transactions.

Point 2

Further, following any such rules would make no sense. One set of rules which the PTO relies on are the "government regulations" of column 3, line 11.

How would government regulations be followed by the POS of column 2, line 35, which is cited to show claim 10 ?

This applies to claim 13

Claims 11 and 14

These claims state that the "organization" offers items for sale. The PTO relies on Slater, column 2, lines 34, 35.

As explained above, that passage in Slater refers to employees obtaining their salaries from terminals, using stored-value cards. That passage does not refer to any sales of items.

The Final Office Action relies on "inherency." However, no "basis in fact" or "technical reasoning" has been given, as required by MPEP § 2112, showing that sales occur.

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Claims 9 and 12

Claim 12 contains several "means" recitations.

35 USC § 112 states:

. . . An element in a claim for a combination may be expressed as a means . . . for performing a specified function without the recital of structure, material, or acts in support thereof,

and

such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Thus, for claim 12 to be shown in Slater, the "corresponding structure, material, or acts described in . . . [Appellant's] specification and equivalents thereof" must be shown in Slater.

That has not been done.

For example, the "means for maintaining a financial account" in claim 12 corresponds to a host 12 in Appellant's Figure 1, and other aspects of the system. The host can be reached through a personal computer PC 28b in Figure 1, to alter funds in the account. (Specification, page 6, lines 22 - 24.)

That has not been shown in Slater.

In addition, the account 90 in host 12 in Appellant's Figure 1 is accessed by the ATM 14a. (Specification, page 8, line 25 et

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seq.)

That has not been shown in Slater.

Further, the Specification states that an "official" at the "school" or organization establishes the rules. (Page 7, lines 12 - 21.) That cannot correspond to the "government regulations" cited in Slater to show the "rules."

One reason is that, by law, government regulations must first be made available to the public, so that public comment may be collected and considered.

Another reason is that government regulations are subject to review by the courts.

This applies to claim 9.

Claims 15 - 17

The Final Office Action, page 4, rejects claim 15 - 17.

These claims were previously cancelled.

Claims 18 - 20

Claims 18 - 20 are dependent claims, and recite

. . . wherein the rules limit times-of-day
when specific transactions are allowed.

Slater, column 2, lines 29, 30, is cited to show this.

However, that passage merely states that the employer deposits

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money into an employee's account, or stored value card, "at periodic intervals."

That does not "limit" a "specific transaction" as claimed.

Further, that does not "limit" a "specific transaction" to a "time-of-day," as claimed. For example, such a limit would mean that lunch money is only available from 11:00 am to 1:00 pm, and not available at other times. Slater's deposits at "periodic intervals" places no limits as to the allowed times of transactions, as claimed.

Claims 21 - 23

Claims 21 - 23 are dependent claims, and recite

. . . wherein a non-authorization message is displayed if the requested transaction fails to comply with a rule.

Plainly, the "non-authorization message" is displayed to the "individual" who is making the "requested transaction."

Slater, column 4, lines 33 - 36 is cited to show this.

However, as explained above, that passage refers to a re-direction of a deposit to a stored value account, during an electronic transfer.

Slater mentions no "non-authorization message," as claimed.

Further, Slater does not state that the (missing) "message" is displayed to the "individual."

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Further still, the operations in Slater occur in cyber space,
/ within computers. Nothing is visible.

Furthermore, the supposed "rejection" in Slater is no rejection at all. It is simply a redirection of a deposit, in the proper manner. In fact, Slater states that the deposit goes through successfully. Thus, there is no reason to present a "non-authorization message" to anybody.

Claims 24 - 26

Appellant never withdrew claims 24 - 26.

They have not been rejected, so they should be allowed.

The discussion above indicates that the recitations of these claims are not found in Slater. For example,

-- Claim 24 recites establishing "rules on the usage of funds in each account." The PTO relies on "government regulations" in Slater to show "rules," but those are clearly irrelevant. The PTO also relies on procedures used during electronic transfers as showing "rules." But such procedures do not correspond to the claimed "rules."

-- As to the claimed "rules," the PTO applies the claim terminology to **two different entities** in Slater. That is not allowed.

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-- Claim 24 recites displaying a "rejection message" if a requested transaction does not follow the rules. That is simply not found in Slater. The "message" is plainly displayed to the person making the request.

In addition, claim 24 states:

d) allowing one or more Automated Teller Machines, ATMs, or their hosts to obtain access to the accounts and rules.

This has not been shown in Slater.

**ARGUMENT RELATING TO VALIDITY OF "CONSTRUCTIVE ELECTION"
TO WITHDRAW CLAIMS 24 - 26**

The Final Office Action, page 2, asserts that Appellant has constructively elected to withdraw claims 24 - 26.

However, several problems exist in this assertion by the PTO.

Problem 1

The assertion is contrary to general legal principles.

In the legal system, a "constructive" election is sometimes assumed, if a party fails to make an **express** election, but acts as though he made the election.

That is, the party's actions "speak" on behalf of the party.

This concept simply does not apply here, because no actions

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by Appellant have been identified which indicate an intent to withdraw the claims in question.

Appellant asks: Why did Appellant undertake the effort to

- 1) write the added claims and
- 2) distinguish them over the prior art,

as done in the previous Amendment, if Appellant intended to ignore the claims ?

From another perspective, the PTO is asserting that Appellant deliberately undertook actions which were pointless. The PTO is asserting that Appellant undertook a premeditated waste of time.

The PTO's assertion is contrary to the facts, and contrary to common sense.

As a minimum, the PTO must explain what purpose was served by Appellant's drafting of claims 24 - 26, if Appellant intended them to be withdrawn immediately upon submission.

That is, the PTO must show some clear purpose in Appellant's submission of the claims, which purpose is different than the usual purpose, namely, of having the claims entered and examined along with the other claims.

Problem 2

The Office Action cites 37 CFR § 1.142(b) and MPEP § 821.03 in support of its position. However, neither of those references supports the PTO's position.

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The CFR section merely states that, if an election is made, the non-elected claims are automatically withdrawn.

But Appellant made no election here.

The MPEP section merely states that, if restrictable claims are added after an office action, then the PTO may issue a restriction requirement.

But neither section discusses a "constructive" election.

Appellant points out that the PTO has not followed the MPEP section which it cited. That section mandates issuance of a restriction requirement, when a second invention appears in added claims.

No restriction requirement has been issued.

Problem 3

The PTO's assertion is without logical foundation. Why were claims 1 - 6 constructively elected, rather than claims 22 - 31 ?

That is, what is the evidentiary basis for the PTO's withdrawing claims 24 - 26, rather than the other pending claims?

What authority allows the PTO to determine which claims are to be examined, as opposed to Appellant making the determination ?

Problem 4

The PTO's basis for the "election" is that claims 24 - 26

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represent a different invention. However, the Office Action applies an incorrect test as to whether a second invention is added by the new claims.

The Office Action states that claims 24 - 26 cover an invention which is "independent **OR** distinct" from that of claims 1 - 6. (Office Action, page 2, first paragraph.)

That is not the legal test. The test is whether the two elements are "independent **AND** distinct." (35 USC § 121; MPEP § 802.)

Therefore, even if the PTO's arguments are correct (which is not so), they are based on an incorrect rule. The PTO applied the wrong rule.

Problem 5

MPEP § 802.01 defines "independent" and "distinct." The Office Action has not applied those definitions, but has merely asserted that claims 24 - 26 cover **something different**, compared with the remaining claims.

However, the mere fact that the two groups of claims are **different** does not mean that they are "independent and distinct."

Further, the law **requires** that different claims cover different subject matter. Thus, the added claims **must be different**. If they are not different, they can be rejected as duplicative.

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Problem 6

MPEP § 802.01 states that "independent" means that the two inventions are "unconnected in design, operation **AND** effect."

Appellant points out that all claims have the same general effects and operation, namely, using an SST to pay for transactions, and placing restrictions on the transactions.

Problem 7

The PTO's position creates a Catch-22.

MPEP § 714 et seq. and 37 CFR § 1.121 state that an Appellant may amend the claims, in response to an Office Action.

But the present Office Action asserts that, if claims are added, which are different from pending claims, then the added claims can be peremptorily withdrawn by the Examiner, without Appellant's choice or consent.

So here is the Catch-22:

-- The rules say that claims can be added.

-- Other rules say that different claims must be different.

-- But the Office Action states that, if different claims are added, the PTO can peremptorily withdraw them.

Thus, it is impossible to amend an application, under the

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PTO's view.

Additional Point 1

The undersigned attorney drafted added claims 24 - 36. At no time did he have an intent to constructively elect to withdraw those claims.

Additional Point 2


The previous Amendment has been entered. The undersigned attorney is aware of no authority which allows the PTO to arbitrarily withdraw selected claims presented in an Amendment. It is requested that the Office Action identify such authority, by way of Examiner's Answer.

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CONCLUSION

Appellant requests that the Board overturn all rejections,
and pass all claims to issue.

Respectfully submitted,


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THREE ATTACHMENTS:

- Claims appendix
- Statement that no Evidence Appendix is attached
- Statement that no Related Proceedings Appendix is attached

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9. CLAIMS APPENDIX

1. A method of providing financial transactions via a self-service terminal associated with an organization having individuals under its supervision, the method comprising the steps of:

maintaining a financial account for the organization;

maintaining a financial account for an individual under the supervision of the organization;

allowing a sponsor and/or the organization to establish rules governing use of funds within the financial account by the individual; and
when a transaction is requested by the individual at a self-service terminal located in premises used by the organization, examining the rules and fulfilling the transaction if the transaction is consistent with the established rules for that individual.

2. A method according to claim 1, further comprising the step of offering the individual products and/or services provided by the organization.

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9. A financial transaction system comprising:
- a) a self-service terminal, SST, in communication with a transaction host, wherein the terminal is associated with an organization having individuals under its supervision;
 - b) means for maintaining a financial account for an individual under the supervision of the organization;
 - c) means for allowing a sponsor and/or the organization to establish rules governing use of the financial account by the individual, said rules being accessible to the SST or the host; and
 - d) means for fulfilling a transaction requested by the individual at the terminal if the transaction is consistent with the established rules for that individual.

10. A system according to claim 9, wherein the terminal is located in premises used by the organization.

11. A system according to claim 9, wherein the terminal includes means for allowing individuals to purchase products and/or

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services offered by the organization to individuals under its supervision.

12. A financial transaction system comprising:
 - a) an automated teller machine (ATM) in communication with a transaction host, wherein the ATM is associated with an organization having individuals under its supervision;
 - b) means for maintaining a financial account for an individual under the supervision of the organization;
 - c) means for allowing a sponsor and/or the organization to establish rules governing use of the financial account by the individual, said rules being accessible to the ATM or the host; and
 - d) means for fulfilling a transaction requested by the individual at the ATM if the transaction is consistent with the established rules for that individual.

13. A system according to claim 12, wherein the ATM is located in premises used by the organization.

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14. A system according to claim 12, wherein the ATM includes means for allowing individuals to purchase products and/or services offered by the organization to individuals under its supervision.

18. Method according to claim 1, wherein the rules limit times-of-day when specific transactions are allowed.

19. Method according to claim 9, wherein the rules limit times-of-day when specific transactions are allowed.

20. Method according to claim 12, wherein the rules limit times-of-day when specific transactions are allowed.

21. Method according to claim 1, wherein a non-authorization message is displayed if the requested transaction fails to comply with a rule.

22. Method according to claim 9, wherein a non-authorization message is displayed if the requested transaction fails to comply with a rule.

23. Method according to claim 12, wherein a non-authorization message is displayed if the requested transaction fails to comply with a rule.

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24. A method of providing account-access to individuals in an organization, comprising:

- a) setting up an account for each individual;
- b) establishing rules on the usage of funds within each account, wherein different accounts have different sets of rules;
- c) maintaining the accounts and the rules in a computer system;
- d) allowing one or more Automated Teller Machines, ATMs, or their hosts to obtain access to the accounts and rules;
- e) when an individual requests a transaction at one of the ATMs, ascertaining whether the transaction complies with the rules for the individual's account and, if so, executing the transaction and, if not, displaying a rejection message.

25. Method according to claim 24, wherein the rules limit times-of-day when specific transactions are allowed.

26. Method according to claim 1, wherein different rules are established for different individuals

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9. EVIDENCE APPENDIX

None.

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10. RELATED PROCEEDINGS APPENDIX

None.